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10/509,137	09/27/2004	Jeffrey S Lockwood	7175-71858	1944
23643 7590 11/24/2008 BARNES & THORNBURG LLP 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204				
EXAMINER REICHLE, KARIN M				
ART UNIT		PAPER NUMBER		
3761				
NOTIFICATION DATE		DELIVERY MODE		
11/24/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

indocket@btlaw.com

### Office Action Summary

**Application No.**

10/509,137

**Applicant(s)**

LOCKWOOD ET AL.

**Examiner**

Karin M. Reichle

**Art Unit**

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2008 and 08 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The use of the trademark TEGADERM and OPSITE FLEXIGRID, page 10, lines 2-3, has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be in all capital letters or with the trademark symbol, not both.

### ***Claim Language Interpretation***

2. Since no claim language has been explicitly defined, such terminology will be given it broadest reasonable interpretation in light of the specification, e.g. its dictionary definition. Therefore, the terminology “channel” is defined by the dictionary not only as “a trench furrow or groove” but also as “a tubular passage for liquids” as well as “a course or passage through which something may be moved or directed”.

### ***Claim Objections***

3. Claims 1-7 and 9 are objected to because of the following informalities: In claim 1, lines 8-9 and in claim 9, lines 10-11, the description as being “open at the top surface” is

redundant, i.e. see previous description of such extending through the surface and the discussion *infra*. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Heaton '127.

Claim 1: See Claim Language Interpretation section *supra* as well as '127 at, e.g., Figures 5-9c, page 2, first full paragraph, page 3, second to last line-page 4, fifth to last line, and page 7, line 12-page 9, last line: the member is 30 and 73 or 30, 73 and 20, the wound contactable layer is 73 having a bottom surface which is the bottom surface of 73, the "discrete" holes are the openings of the cells of open celled foam of 73 extending through the bottom surface thereof, the cover is 30 or 30 and 20 or 20 with the at least one "discrete" opening being 34 and/or 25 extending through the top surface thereof and the port is at least 36 which is configured to communicate with the vacuum source and in fluid communication with each "discrete" hole and the at least one "discrete" opening (It is noted that "communicate" includes direct and/or indirect communication). With regard to lines 3-4 of claim 1 attention is again directed to page 4, lines 10-12. See also the response to Arguments section *infra*. Claim 1 now also requires the at least one discrete opening extending through a top surface of the cover be open at the top surface such that negative pressure is communicated to an undermined portion of

the wound through the at least one discrete opening. It is noted however that such language does not require direct communication to the portion of the wound, i.e. does not require the opening be directly open to the undermined portion, e.g. the opening having no structure over/connected over it or about it, i.e. an aperture through a surface which has a connector/structure located above it/around it is still open at the surface, e.g. open to the connector/structure. Therefore see 25 in Figures 4 and 7 and/or 34 in Figures 5 and 7 and the description at page 4, lines 1-2 and page 7, last paragraph, i.e. an aperture 25 and/or 34 is open at the top surface such that pressure is communicated to the wound therethrough as claimed.

Claim 2: See the Claim Language Interpretation section supra, e.g. the definition of “channels”, and the portions of ‘127 cited supra, especially page 4, lines 10-12, and thereby, by incorporation, ‘873, at, e.g., Figure 10 and the paragraph bridging pages 8-9, i.e. clearly teaches the wound contactable layer of a wound cover packed into the recesses of the wound cavity, i.e. the wound contactable layer 73 includes a bottom surface adapted to be in contact with and generally conform to the wound surface, the “channels” of the upper surface are formed by the cells/pores/passages in the foam material thereof opening through such surface, e.g. “a tubular passage for liquids” or “a course or passage through which something may be moved or directed” (note no specific shapes and/or dimensions and/or patterns of “channels” are claimed) and the cover 20 and/or 30 has a bottom surface which engages with the top surface of the wound contactable layer and cooperates with such “channels” to define a plurality of passageways between the port and each discrete hole and between the port and the at least one discrete opening. It is noted that the claim does not require the bottom surface of the cover

facing the wound contactable layer be entirely planar and/or each of the passageways being a discrete passageway between the port and each hole or between the port and each opening.

Claim 3: See the Claim Language Interpretation section supra and Figure 7 of '127, i.e. a surface area of the cover, e.g. 30, is smaller than a surface area of the layer 73 so that layer 73 and thereby, the "channels"/spaces/passages of the foam material thereof, extend beyond an outer edge of cover 30 and define a plurality of the "discrete" openings, i.e. the "channels"/spaces/passages of 73 at the top surface thereof laterally beyond 30.

Claim 8: See the discussion of claims supra and the discussion infra of the new claim language with regard to lines 1-14. With regard to lines 14 et seq, see the discussion of claim 3, i.e. the foam of 73, i.e. its interconnecting cells/ pores/passages, extends beyond cover 30 to define a plurality of "channels" in the periphery thereof, i.e. peripheral access channels. It is noted that this claim only sets forth that such channels be configured to communicate negative pressure with the undermined portion, i.e. a function, capability or property of the "channel" configuration/structure. See again the portions of '127 cited supra as well as the paragraph bridging pages 7-8 and the last full paragraph of page 8 of '873 incorporated thereby, i.e. '127 teaches the claimed structure located in undermined wound portions as well as such structure being capable of communicating negative pressure through the interconnecting cells/passages/pores, i.e. the "channels" thereof. Therefore, at the very least, if not explicit already, there is sufficient factual evidence for one to conclude that such structure, i.e. configuration, of the wound contactable layer of '127 would inherently include the same capability, function or property as claimed, see MPEP 2112.01.

Claim 8 now claims the cover having a planar bottom surface that engages the top surface of the wound contactable layer and cooperates with the channels extending along the top surface of the wound contacting contactable layer to define a plurality of passageways connecting each hole with the port. It is noted that the claim does not require that the entire surface which faces the wound contactable layer be generally planar. Furthermore, see the Figures, esp. 5-7, and, e.g., the sentence bridging pages 3-4, i.e. at the very least either the surfaces of the projections of 32 which contact layer 73 or the bottom surface of the portion 30, e.g. adjacent 31, are generally planar.

6. Claims 1-2 and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Lockwood et al '794.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim 1: See the Claim Language Interpretation section supra as well as '794 at, e.g., the Figures, especially 1-17, the abstract and col. 7, line 46-col. 10, line 24 and col. 11, lines 19-29, i.e. the member is 20 and 52, the wound contactable layer is 20 having a bottom surface which is adapted to be in contact with and generally conform to the wound surface, the "discrete" holes are 36 extending through the bottom surface thereof, the cover is 52 which includes at least one "discrete" opening, see 51 or Figure 15, extending through the top surface thereof and the port is

at 13 and/or 26 or 70 which is configured to communicate with the vacuum source and in fluid communication with each “discrete” hole and the at least one “discrete” opening (It is noted that “communicate” includes direct and/or indirect communication). As discussed supra claim 1 now also requires the at least one discrete opening extending through a top surface of the cover be open at the top surface such that negative pressure is communicated to an undermined portion of the wound through the at least one discrete opening. It is noted however that such language does not require direct communication to the portion of the wound, i.e. does not require the opening be directly open to the undermined portion, e.g. the opening having no structure over/connected over it or about it, i.e. an aperture through a surface which has a connector/structure located above it/around it is still open at the surface, e.g. open to the connector/structure. Therefore, see, e.g., Figures 5, and 15-19, i.e. an aperture is open at the top surface such that pressure is communicated to the wound therethrough as claimed.

Claim 2: See the Claim Language Interpretation section supra, i.e. the definition of “channels”, and the portions of ‘794 cited supra, i.e. the “channels” of the upper surface are 30 and the cover 52 has a bottom surface which engages with the top surface of the wound contactable layer and cooperates with such channels to define a plurality of passageways between the port and each discrete hole and between the port and the at least one discrete opening as claimed. It is noted that the claim does not require the bottom surface of the cover which faces the wound contactable layer be entirely planar and/or each of the passageways being a discrete passage way between the port and each hole or between the port and each opening.



Claim 4: See the Claim Language Interpretation section *supra*, the discussion of claim 1 *supra* and Figure 15 again, i.e. '794 teaches the cover includes more than one of the discrete openings through the top surface thereof in communication with channels 28.

Claim 5: See the discussion of claims 1, 2 and 4 *supra*. Claim 5 further requires the claimed structure be adapted to communicate negative pressure to undermined portions of the wound, i.e. a function, capability or property of the claimed structure. However, '794 teaches the claimed structure as well as the capability of contacting and conforming to wound surfaces. Therefore, at the very least, there is sufficient factual evidence for one to conclude that such structure of the cover of '794 would inherently include the same capability, function or property as claimed, see MPEP 2112.01.

Claim 6: See the Claim Language Interpretation section *supra* and the discussion of the claims *supra*, i.e. '794 teaches the claimed structure and a cover including a outer peripheral portion (It is noted that no specific dimension of such portion is claimed nor the specific relationship of such with regard to the remaining portions of the cover is claimed) and such cover including at least two openings which are closer to the periphery or edge than other openings or the center point, see Figures 12 and 15.

Claim 7: The terminology "relative thin and flexible" is considered relative absent the claiming of specific dimensions of thinness and flexibility. See also '794 at the portions cited with respect to claim 1 and col. 11, lines 54-57, e.g. layers described as "thin" and "flexible" and "pliable". Therefore the member is also considered to be "relatively thin" and "flexible".

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 4-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton '127 in view of Ohmstede PCT '173.

Claim 4: This claim requires at least two discrete openings in the cover capable of communication whereas the cover, e.g. 20 and/or 30, only includes one such discrete opening which is capable of communication. However, see '173 at the abstract, second to last line, i.e. "one or more openings", and Figures 2-4, i.e. suction head/foam pad combination for attaching to a wound area similar to that of '127 which employs one or more than one opening, i.e. interchangeability of more than one opening for one opening. To make the one opening of the suction head/plate shaped member of '127 more than one opening would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by '173. The combination of the prior art would necessarily and inevitably include the claimed structure. See also the discussion of claim 1 *supra*.

Claim 5: See the discussion of claims 1, 3 and 4.

Claim 6: See the discussion of the claims *supra*, i.e. the prior art teaches a cover including a outer peripheral portion (It is noted that no specific dimension of such portion is claimed nor the specific relationship of such with regard to the remaining portions of the cover is claimed) and such cover includes openings of which at least two are closer to the periphery or edge, i.e. an outer peripheral portion, than other openings and/or a center point, i.e. see the leftmost and rightmost openings 20 in Figures 2-4 of '173.

Claims 9 and 11: See the discussion of claims 1-6 and 8 supra.

Claims 7 and 10: The terminology "relative thin and flexible" is considered relative absent the claiming of specific dimensions of thinness and flexibility. See also '127 at the portions cited with respect to claim 1, e.g. layer 73 is described as "relatively thin" and "flexible" and extends beyond 30, i.e. defines peripheral portions of the member. Therefore the member is also considered to be "relatively thin" and "flexible".

### ***Double Patenting***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-2 and 4-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8 and 30 of U.S. Patent No. 6,752,794 in view of Ohmstede PCT '173 and Heaton PCT '127. With regard to claims 1-2, since the instant application has a later effective filing date, the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the patent claims? The answer is yes. Claims 1-2 of the instant application are both broader with regard to some aspects and narrower with regard to other aspects of the patent claims. With regard to the broader aspects (e.g. patent claims non-porous material or connector with right angled passageway and the application does not), once an applicant has received a patent for a species or more specific embodiment, he is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader, i.e. the patented claim anticipates the application claim. See In re Goodman, supra. With regard to the narrower aspects (e.g. the application claims claim at least

one discrete opening extending through a top surface of the cover), while the patent claims require a cover which is formed to include a port such does not claim the port so formed through the top surface. However, it is well known to provide a port through the top surface of a cover of such member for use in a vacuum bandage, see, e.g., PCT '127 and '173 at the Figures, to simplify the connection of the various parts of the bandage to each other and to the patient. Therefore, to provide the port, i.e. at least one discrete opening, through the top surface of the cover of the patent claims as taught by '127 and '173 would be obvious to one of ordinary skill in the art in view of the recognition that such simplifies connection and use of such bandage and the desire of ease/simplification of use in any medical device. For the reasons discussed supra with regard to the scope of the claim language of claim 1, such prior art combination would necessarily and inevitably also include such opening being open at the top surface as now claimed.

Claim 4: This claim requires at least two discrete openings in the cover capable of communication whereas the patent claims only include one discrete opening/port which is capable of communication. However, see '173 at the abstract, second to last line, i.e. "one or more openings", and Figures 2-4, i.e. wound contacting layer/cover combination of vacuum bandage for attaching to a wound area similar to that of '127 which employs one or more than one opening through the cover in combination with a port, i.e. interchangeability of more than one opening for one opening. To make the port/one opening of the patent claims a port/more than one opening would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by '173. The combination would necessarily and inevitably include the claimed structure.

Claim 5: See the discussion of claims 1, 2 and 4.

Claim 6: See the discussion of the claims *supra* and lines 1-6 of claim 30, i.e. the prior art teach a cover including a outer peripheral portion (It is noted that no specific dimension of such portion is claimed nor the specific relationship of such with regard to the remaining portions of the cover is claimed) and such cover including at least two openings which are closer to the periphery or edge than other openings or the center point, see, e.g., the leftmost and rightmost opening 20 in Figures 2-4 of '173.

Claim 7: The terminology "relative thin and flexible" is considered relative absent the claiming of specific dimensions of thinness and flexibility. See also '794 at the preamble of claim 1 from which claim 8 depends, e.g. member is described as "thin" and "flexible". Therefore the member is also considered to be "relatively thin" and "flexible" as claimed.

### ***Response to Arguments***

11. Applicant's remarks have been considered but are either deemed moot in that the issue has not been reraised or deemed not persuasive for the reasons set forth *supra*. Specifically Applicant's remarks are narrower than the claim language, e.g. as discussed *supra* the claims do not require the discrete opening be directly open to the undermined portion at the top surface and direct communication of the negative pressure therefrom to the undermined portion, and/or the teachings of the prior art, e.g. Heaton does teach at least one discrete opening extending through the top surface of the cover, i.e. open at the top surface, and/or the prior art/double patenting rejections, i.e. the 103/ double patenting rejections do set forth an explicit analysis and reason for combination.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any new grounds of rejection were necessitated by the amendments to claims 1, 3, 4, 6, 8 and 9.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karin M. Reichle/  
Primary Examiner, Art Unit 3761

November 15, 2008